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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,529	03/11/2005	Christian Wulff	267332US0PCT	7443
22850	7590	11/20/2006		
C. IRVIN MCCLELLAND OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314				
EXAMINER KEYS, ROSALYND ANN				
ART UNIT		PAPER NUMBER		
1621				

DATE MAILED: 11/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/527,529

Applicant(s)

WULFF ET AL.

Examiner

Rosalynd Keys

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-21 is/are pending in the application.
- 4a) Of the above claim(s) 21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. Claims 10-21 are pending.
Claims 10-20 are rejected.
Claims 1-9 are canceled.
Claim 21 is withdrawn from consideration.

Election/Restrictions

2. Newly submitted claim 21 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the product as claimed in claim 21 can be made by a materially different process than the process disclosed in claims 10-20.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 21 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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5. Claims 10-13, 16, 17, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clement et al. (US 6,429,342 B1), for the reasons given in the previous office action, mailed May 26, 2006.

6. Claims 10, 14, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kosmin (US 2,508,036) in view of Clement et al. (US 6,429,342 B1), for the reasons given in the previous office action, mailed May 26, 2006.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 10-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 9 of copending Application No. 10/528,414 in view of Clement et al. (US 6,429,342 B1), for the reasons given in the previous office action, mailed May 26, 2006.

Response to Arguments

Rejection of claims 10-13, and 16 under 35 U.S.C. 103(a) as being unpatentable over Clement et al. (US 6,429,342 B1)

9. Applicant's arguments filed August 26, 2006 have been fully considered but they are not persuasive.

The Applicants argue that Clement et al. only recite suitable initiator compounds that are chosen from short chain monoalcohols having 1 to 8 C-atoms, long chain alcohols having 18 C-atoms, hydroxyalkyl acrylates and methacrylates, polyalcohols and polyether polyols having a molecular weight of from 125 to 1000, which do not include the presently claimed starter compounds chosen from monofunctional linear or singly or multiply branched alcohols having from 10 to 15 carbon atoms. As such, the reference clearly does not describe the presently claimed invention. This argument is not persuasive because the Applicants are trying to limit Clement to its preferred embodiments. However, it is well established that a prior art disclosure is not limited to its working examples or to its preferred embodiments, but must be evaluated for what it teaches those of ordinary skill in the art. Merck & Co. Inc. v. Biocraft Labs. Inc., 874 F.2d 804, 807, 10 USPQ2d 1843, 1846 (Fed. Cir. 1989); In re Fracalossi, 681 F.2d 792, 794 n.1, 215 USPQ 569, 570 n.1 (CCPA 1982); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 278, 280 (CCPA 1976); In re Boe, 355 F. 2d 961, 965, 148 USPQ 507, 510 (CCPA 1966). In the instant case Clement et al. teach that the initiator compound is a material having at least one oxyalkylatable group, wherein oxyalkylatable group is meant a heteroatom-containing group that can react with ethylene oxide in a ring-opening reaction to form a covalent bond between the heteroatom and a carbon atom of the ethylene oxide. The heteroatom is preferably oxygen or sulfur and is usually attached to a hydrogen atom (see column 4, lines 56-65). The specific alcohols expressly disclosed by Clement et al include a carbon 8 (octanol) and a carbon 18

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(octadecanol) alcohol. Thus, based upon these teaching the Examiner believes that one having ordinary skill in the art would have found it obvious to utilize an initiator compound having from 10-15 carbon atoms in the process of Clement. Thus, the instant claims are unpatentable over Clement et al.

The Applicants arguments with respect to Clement preference to using compounds having molecular weights of 700 is not persuasive because 1) the Examiner does not see any teaching in Clement wherein compounds having a molecular weights of 700 are preferred and 2) even if this were the case, as disclosed above a reference is not limited to its preferred its preferred embodiments, but must be evaluated for what it teaches those of ordinary skill in the art. In the instant case Clement teaches the use of initiator compounds having molecular weights of 1000 or less, including those having an equivalent weight of from about 125, preferably to about 150 (see column 4, line 64 to column 5, line 15).

For the above reasons this rejection is maintained.

New claims 17, 19 and 20 are also unpatentable for the same reasons claim 10 is unpatentable.

Rejection of claims 10, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kosmin (US 2,508,036) in view of Clement et al. (US 6,429,342 B1)

10. Applicant's arguments filed August 26, 2006 have been fully considered but they are not persuasive.

The Applicants argue that Kosmin do not describe or suggest the use of double metal cyanide catalyst. This argument is not persuasive because the Examiner pointed this deficiency out in the previous office action and gave reasons why one would be motivated to replace the KOH catalyst of Kosmin with the dmc catalyst of Clement et al. The Applicants have not presented arguments sufficient to rebut the Examiner's position. In response to applicant's

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argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the instant case Kosmin teaches alkoxylation of 2-n-propyl-heptanol, but with a KOH catalyst. Clement et al. teach alkoxylation of alcohols, which broadly includes 2-n-propyl-heptanol, and gives the motivation to substitute a dmc catalyst for a KOH catalyst. Thus, the Examiner believes that the instant claims are prima facie obvious over the teachings of Kosmin in view of the teachings of Clement et al.

For the above reasons this rejection is maintained.

New claim 18 is also unpatentable for the same reasons claim 14 is unpatentable.

Provisional Rejection of claims 10-16 on the ground of nonstatutory obviousness-type double patenting

12. No arguments were presented to rebut this rejection. Thus, this rejection is maintained.

New claims 17-20 are unpatentable for the same reasons claims 10-16 are unpatentable.

Conclusion

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO


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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rosalynd Keys whose telephone number is 571-272-0639. The examiner can normally be reached on M, W & F 5:30-7:30 am & 1-5 pm; T & Th 5:30 am-4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Rosalynd Keys
Primary Examiner
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November 10, 2006